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Atty Docket No. RCA89186 US

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants: Hugh B. Morrison et al.
Serial Number: 09/868,426
Atty. Dkt: RCA 89,186
Filing Date: June 15, 2001
For: METHOD FOR OPERATING A VIDEO PROCESSING
APPARATUS VIA AN ELECTRONIC MAIL MESSAGE
Art Unit: 2623
Examiner: Dominic D. Saltarelli

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the final Office Action dated September 5, 2007 and the Advisory Action dated November 23, 2007, and further to the Notice of Appeal filed on February 4, 2008, Appellants hereby submit an Appeal Brief in accordance with 37 C.F.R. §41.37 for the above-referenced application.

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being faxed to the United States Patent & Trademark Office, fax # 571-273-8300, Mail Stop: Appeal Brief-Patents on:

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Fideliz Romero
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I. Real Party in Interest

The real party in interest is Thomson Licensing LLC.

II. Related Appeals and Interferences

There are no prior or pending appeals, interferences, or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 10-29 are pending in this application, and are rejected. Claims 1-9 are cancelled. The rejection of claims 10-29 is being appealed.

IV. Status of Amendments

No amendment subsequent to the final rejection of September 5, 2007 has been filed.

V. Summary of Claimed Subject Matter

Independent claim 10 defines a method for operating a video processing apparatus, comprising steps of: receiving an electronic mail message remotely from a user (page 6, lines 1-3; step 302 of FIG. 3), said electronic mail message (element 500 of FIG. 5) comprising an operating command (element 506 of FIG. 5) and program identification information including at least one of a first type of program identification information and a second type of program identification information (page 8, lines 15-28; element 508 of FIG. 5); processing said electronic mail message to determine whether said electronic mail message includes said first type of program identification information (page 6, lines 9-10; step 314 of FIG. 3); scheduling an event responsive to said operating command for a program identified by said program identification information without searching program guide information for said program if said electronic mail message includes said first type of program identification information (page 6, lines 9-12; "YES" branch of step 314 proceeding to step 316, and thereby avoiding step 324 of FIG. 3); continuing to process said electronic mail message to

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determine whether said electronic mail message includes said second type of program identification information only if said electronic mail message does not include said first type of program identification information (page 6, lines 13-15; "NO" branch of step 314 proceeding to step 320 of FIG. 3); searching said program guide information for said program using said program identification information only if said electronic mail message includes said second type of program identification information and does not include said first type of program identification information (page 6, lines 17-19; "YES" branch of step 320 proceeding to step 324 of FIG. 3); and scheduling said event responsive to said operating command if said program is found during said searching step (page 6, lines 21-23; step 316 of FIG. 3).

Independent claim 17 defines an apparatus (FIG. 1), comprising: first means (element 1113 of FIG. 1) for receiving an electronic mail message remotely from a user (page 6, lines 1-3; step 302 of FIG. 3), said electronic mail message (element 500 of FIG. 5) comprising an operating command (element 506 of FIG. 5) and program identification information including at least one of a first type of program identification information and a second type of program identification information (page 8, lines 15-28; element 508 of FIG. 5); second means (element 1110 of FIG. 1; page 5, lines 22-23) for processing said electronic mail message to determine whether said electronic mail message includes said first type of program identification information (page 6, lines 9-10; step 314 of FIG. 3), and for scheduling an event responsive to said operating command for a program identified by said program identification information without searching program guide information for said program if said electronic mail message includes said first type of program identification information (page 6, lines 9-12; "YES" branch of step 314 proceeding to step 316, and thereby avoiding step 324 of FIG. 3); said second means (element 1110 of FIG. 1; page 5, lines 22-23) continuing to process said electronic mail message to determine whether said electronic mail message includes said second type of program identification information only if said electronic mail message does not include said first type of program identification information (page 6, lines 13-15; "NO" branch of step 314 proceeding to step 320 of FIG. 3); and said second means (element 1110 of FIG. 1; page 5, lines 22-23) searching said program guide information for said program using said program identification

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information only if said electronic mail message includes said second type of program identification information and does not include said first type of program identification information (page 6, lines 17-19; "YES" branch of step 320 proceeding to step 324 of FIG. 3), and scheduling said event responsive to said operating command if said program is found during said searching (page 6, lines 21-23; step 316 of FIG. 3).

Independent claim 24 defines a video processing apparatus (FIG. 1), comprising: an interface (element 1113 of FIG. 1) operative to receive an electronic mail message remotely from a user (page 6, lines 1-3; step 302 of FIG. 3), said electronic mail message (element 500 of FIG. 5) comprising an operating command (element 506 of FIG. 5) and program identification information including at least one of a first type of program identification information and a second type of program identification information (page 8, lines 15-28; element 508 of FIG. 5); a processor (element 1110 of FIG. 1; page 5, lines 22-23) operative to process said electronic mail message to determine whether said electronic mail message includes said first type of program identification information (page 6, lines 9-10; step 314 of FIG. 3), and to schedule an event responsive to said operating command for a program identified by said program identification information without searching program guide information for said program if said electronic mail message includes said first type of program identification information (page 6, lines 9-12; "YES" branch of step 314 proceeding to step 316, and thereby avoiding step 324 of FIG. 3); said processor (element 1110 of FIG. 1; page 5, lines 22-23) continuing to process said electronic mail message to determine whether said electronic mail message includes said second type of program identification information only if said electronic mail message does not include said first type of program identification information (page 6, lines 13-15; "NO" branch of step 314 proceeding to step 320 of FIG. 3); and said processor (element 1110 of FIG. 1; page 5, lines 22-23) searching said program guide information for said program using said program identification information only if said electronic mail message includes said second type of program identification information and does not include said first type of program identification information (page 6, lines 17-19; "YES" branch of step 320 proceeding to step 324 of FIG. 3), and scheduling said event responsive to said

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operating command if said program is found during said searching (page 6, lines 21-23;
step 316 of FIG. 3).

VI. Ground of Rejection to be Reviewed on Appeal

The rejection of claims 10-29 under 35 U.S.C. §103(a) based on U.S. Patent No. 6,374,406 issued to Hirata (hereinafter, "Hirata") in view of WO 99/35847 (hereinafter, "Westlake"), and further in view of U.S. Patent No. 4,286,325 issued to Dlugos et al. (hereinafter, "Dlugos") is presented for review in this appeal.

VII. Argument

The rejection of claims 10-29 under 35 U.S.C. §103(a) based on the proposed combination of Hirata, Westlake and Dlugos should be reversed for at least the following reasons.

Appellants first note that independent claim 10 recites:

"receiving an electronic mail message remotely from a user, said electronic mail message comprising an operating command and program identification information including at least one of a first type of program identification information and a second type of program identification information;

processing said electronic mail message to determine whether said electronic mail message includes said first type of program identification information;

scheduling an event responsive to said operating command for a program identified by said program identification information without searching program guide information for said program if said electronic mail message includes said first type of program identification information;

continuing to process said electronic mail message to determine whether said electronic mail message includes said second type of program identification information **only if said electronic mail message does not include said first type of program identification information;**

searching said program guide information for said program using said program identification information **only if said electronic mail message includes said second type of program identification information and does not include said first type of program identification information;** and

scheduling said event responsive to said operating command if said program is found during said searching step." (emphasis added)

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As indicated above, independent claim 10 defines a method for scheduling an event (e.g., program recording, etc.) responsive to a received electronic mail message that includes an operating command and at least one of two different types of program identification information (e.g., channel/time information and/or a program name). The received electronic mail message is processed to determine whether it includes the first type of program identification information. An event is scheduled responsive to the operating command for a program identified by the program identification information without searching program guide information for the program if the electronic mail message includes the first type of program identification information.

Also according to the method, the electronic mail message continues to be processed to determine whether it includes the second type of program identification information only if the electronic mail message does not include the first type of program identification information. The program guide information is then searched for the program using the program identification information only if the electronic mail message includes the second type of program identification information and does not include the first type of program identification information. An event is scheduled responsive to the operating command if the program is found during the search of the program guide information. Independent claims 17 and 24 define subject matter similar to independent claim 1, but are written in "apparatus" format.

A. The Proposed Combination Of References Fails To Teach Or Suggest All Elements Of The Claimed Invention

Appellants submit that neither Hirata, Westlake nor Dlugos, whether taken individually or in combination, teach or suggest all of the foregoing elements of independent claims 10, 17 and 24 (and their respective dependent claims). On pages 3-4 of the final Office Action dated September 5, 2007, the Examiner admits:

"Hirata fails to disclose continuing to process said electronic mail message to determine whether said electronic mail message includes

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said second type of program identification information only if said electronic mail message does not include said first type of program identification information, searching said program guide information for said program using said program identification information only if said electronic mail message includes said second type of program identification information and does not include said first type of program identification information, and scheduling said event if said program is found during said searching step."

As indicated above, the Examiner admits that the primary reference Hirata fails to disclose, *inter alia*, the claimed "continuing to process...." and "searching said program guide information...." elements of independent claims 10, 17 and 24. The Examiner attempts to remedy a part of this deficiency of Hirata by relying on Westlake. In particular, the Examiner ostensibly alleges that Westlake teaches the claimed "searching said program guide information ..." element of independent claims 10, 17 and 24 (see page 4 of the final Office Action dated September 5, 2007). However, Appellants note that Westlake does not teach or suggest, *inter alia*, the claimed "searching said program guide information...." element as defined by independent claims 10, 17 and 24.

Westlake teaches a method that includes steps of receiving an electronic message and comparing terms in the received electronic message to terms in the program information of an electronic program guide (EPG) (see, for example, page 23, lines 14-28 and steps S1-S2 of FIG. 3). The Examiner alleges that these steps of Westlake correspond to:

"... determining if a received electronic mail message includes a second type of program identification information and searching program guide information for an identified program using said program identification information" (see page 4 of the final Office Action dated September 5, 2007).

In response, Appellants note that the aforementioned comparison step of Westlake is ostensibly performed for all terms included in the received electronic message and without regard to whether certain information is included or not included in the received electronic message. In other words, Westlake does not teach or

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suggest, *inter alia*, the conditional language included in the step of "searching said program guide information for said program using said program identification information only if said electronic mail message includes said second type of program identification information and **does not include** said first type of program identification information" (emphasis added) because Westlake never determines if the electronic message "does not include said first type of program identification information" as claimed. Accordingly, the proposed combination including Westlake fails to teach or suggest, *inter alia*, the claimed step of: "searching said program guide information for said program using said program identification information only if said electronic mail message includes said second type of program identification information and does not include said first type of program identification information" (see, for example, claim 10).

On page 5 of the final Office Action dated September 5, 2007, the Examiner further admits that:

"Hirata and Westlake fail to disclose continuing to process the electronic mail message only if the first type of program identification information is not included."

As indicated above, the Examiner admits that the proposed combination of Hirata and Westlake fails to disclose, *inter alia*, the claimed "continuing to process...." element of independent claims 10, 17 and 24. The Examiner attempts to remedy this deficiency of the Hirata/Westlake combination by relying on Dlugos. In particular, the Examiner alleges:

"In an analogous art, Dlugos teaches performing a searching operation, where a search is first performed on a first set, and only broadens the search to a [sic] additional or more generic set if a match is not found in the first search, providing the benefit of avoiding unnecessary searching (col. 29, lines 7-68)"

In response, Appellants note that Dlugos discloses a system and method for determining the postage of an article to be mailed for various domestic and international classes of postal service (see Abstract). As such, the proposed combination including

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Dlugos fails to teach or suggest, *inter alia*, the claimed "continuing to process said electronic mail message to determine whether said electronic mail message includes said second type of program identification information only if said electronic mail message does not include said first type of program identification information" element (emphasis added) of independent claims 10, 17 and 24. In fact, Dlugos does not teach or suggest anything about an "electronic mail message". This is not surprising given its issue date of August 25, 1981, which is likely many years before "electronic mail messages" were even known by most individuals skilled in the art. Accordingly, Dlugos fails to remedy the deficiencies of the Hirata/Westlake combination, and the proposed combination of Hirata/Westlake/Dlugos fails to teach or suggest all elements of independent claims 10, 17 and 24 (and their respective dependent claims). For this reason alone, the instant rejection should be reversed.

B. The Dlugos Reference Constitutes "Non-Analogous Art" Under Federal Circuit Law

Appellants further note that Dlugos, which discloses a system and method for determining the postage of an article to be mailed for various domestic and international classes of postal service, constitutes "non-analogous art" under the law of the Federal Circuit, and therefore has no legal bearing on the determination of obviousness under 35 U.S.C. §103 in this case.

The determination of whether a prior art reference is analogous or not is based on a two-step test. In particular, under the two-step test for determining whether a prior art reference is non-analogous, and thus not relevant in determining obviousness, it must be determined (1) whether the reference is "within the field of the inventor's endeavor," and (2) if not, whether the reference is "reasonably pertinent to the particular problem with which the inventor was involved." See, for example, In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

With respect to step (1), the Dlugos reference endeavors to provide a system and method for determining the postage of an article to be mailed for various domestic and international classes of postal service (see Abstract). In contrast, the claimed

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invention endeavors to provide a method and apparatus for scheduling an event (e.g., program recording, etc.) responsive to a received electronic mail message that advantageously provides enhanced performance and versatility by being able to schedule the event in response to at least two different types of program identification information (e.g., channel/time information and/or a program name). Accordingly, Dlugos is clearly not "within the field of the inventor's endeavor", and therefore fails step (1) of the two-step test.

Next, with respect to step (2), one of ordinary skill in the art would not likely even consider looking at prior art such as Dlugos related to determining the postage of an article to be mailed for various domestic and international classes of postal service when confronted with the problem of how to provide a method and apparatus capable of scheduling an event (e.g., program recording, etc.) responsive to a received electronic mail message that advantageously provides enhanced performance and versatility by being able to schedule the event in response to at least two different types of program identification information (e.g., channel/time information and/or a program name) as claimed. This is clearly evidenced by the fact that Dlugos was issued on August 25, 1981 which is likely many years before "electronic mail messages" were even known by most individuals skilled in the art. Accordingly, the Dlugos reference is clearly not "reasonably pertinent to the particular problem with which the inventor was involved" and therefore also fails step (2) of the two-step test.

In the Advisory Action dated November 23, 2007, the Examiner responds to Appellants' foregoing "non-analogous art" argument by stating:

"Applicant argues that the Dlugos reference is non-analogous art and thus has no legal bearing on the test of obviousness [sic] under 35 USC 103(a). However, the problem at hand that provides the nexus between the Hirata and Westlake combination and the Dlugos reference is the issue of automated searching algorithms performed by a computer to locate data of interest. The idea of performing a first, more narrow search for data, then only broadening the search if it is not found in the first pass is well known in the art, and Dlugos is provided simply as evidence of this fact." (emphasis added)

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In response, Appellants submit that the Examiner's response above does not apply the Federal Circuit's two-step test for determining whether a prior art reference is non-analogous. At best, the Examiner's response above attempts to address only step (2) of the two-step test (i.e., whether the reference is "reasonably pertinent to the particular problem with which the inventor was involved."). However, this attempt mischaracterizes the "particular problem with which the inventor was involved", and also mischaracterizes the primary objectives of Dlugos. As indicated above, the particular problem with which the Appellants were involved was the problem of how to provide a method and apparatus capable of scheduling an event (e.g., program recording, etc.) responsive to a received electronic mail message that advantageously provides enhanced performance and versatility by being able to schedule the event in response to at least two different types of program identification information (e.g., channel/time information and/or a program name), not the problem related to "automated searching algorithms performed by a computer to locate data of interest" (as alleged above) when determining the postage of an article to be mailed for various domestic and international classes of postal service (as addressed by Dlugos). Accordingly, Appellants maintain that Dlugos constitutes "non-analogous art" under the law of the Federal Circuit, and therefore has no legal bearing on the determination of obviousness under 35 U.S.C. §103 in this case.

C. Conclusion

As explained above, the proposed combination of Hirata, Westlake and Dlugos fails to teach or suggest all of the elements of independent claims 10, 17 and 24 (and their respective dependent claims). Moreover, Dlugos is non-analogous art and should not be considered relevant in determining obviousness under 35 U.S.C. §103 in this case. Accordingly, Appellants respectfully request that the Board reverse the rejection of claims 10-29, and pass this application to issue.

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VIII. Claims Appendix

10. A method for operating a video processing apparatus, comprising steps of:

receiving an electronic mail message remotely from a user, said electronic mail message comprising an operating command and program identification information including at least one of a first type of program identification information and a second type of program identification information;

processing said electronic mail message to determine whether said electronic mail message includes said first type of program identification information;

scheduling an event responsive to said operating command for a program identified by said program identification information without searching program guide information for said program if said electronic mail message includes said first type of program identification information;

continuing to process said electronic mail message to determine whether said electronic mail message includes said second type of program identification information only if said electronic mail message does not include said first type of program identification information;

searching said program guide information for said program using said program identification information only if said electronic mail message includes said second type of program identification information and does not include said first type of program identification information; and

scheduling said event responsive to said operating command if said program is found during said searching step.

11. The method of claim 10, wherein:

said first type of program identification information includes channel and time information for said program; and

said second type of program identification information includes a name of said program.

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12. The method of claim 10, wherein said operating command represents one of a request to record said program and a request to watch said program.

13. The method of claim 12, wherein:
said video processing apparatus is scheduled to record said program if said operating command represents said request to record said program; and
said video processing apparatus is scheduled to power on if said operating command represents said request to watch said program.

14. The method of claim 10, further comprising a step of sending a second electronic mail message from said video processing apparatus to said user if said program is not found during said searching step, said second electronic mail message indicating that said electronic mail message included insufficient program identification information.

15. The method of claim 10, wherein said electronic mail message further comprises a password and further comprising a step of sending a second electronic mail message from said video processing apparatus to said user if said password is incorrect.

16. The method of claim 10, further comprising of a step of sending a second electronic mail message from said video processing apparatus to said user if said event is scheduled.

17. An apparatus, comprising:
first means for receiving an electronic mail message remotely from a user, said electronic mail message comprising an operating command and program identification information including at least one of a first type of program identification information and a second type of program identification information;
second means for processing said electronic mail message to determine whether said electronic mail message includes said first type of program identification information, and for scheduling an event responsive to said operating command for a

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program identified by said program identification information without searching program guide information for said program if said electronic mail message includes said first type of program identification information;

said second means continuing to process said electronic mail message to determine whether said electronic mail message includes said second type of program identification information only if said electronic mail message does not include said first type of program identification information; and

said second means searching said program guide information for said program using said program identification information only if said electronic mail message includes said second type of program identification information and does not include said first type of program identification information, and scheduling said event responsive to said operating command if said program is found during said searching.

18. The apparatus of claim 17, wherein:

said first type of program identification information includes channel and time information for said program; and

said second-type of program identification information includes a name of said program.

19. The apparatus of claim 17, wherein said operating command represents one of a request to record said program and a request to watch said program.

20. The apparatus of claim 19, wherein:

said apparatus is scheduled to record said program if said operating command represents said request to record said program; and

said apparatus is scheduled to power on if said operating command represents said request to watch said program.

21. The apparatus of claim 17, wherein a second electronic mail message is sent from said apparatus to said user if said program is not found during said searching, said second electronic mail message indicating that said electronic mail message included insufficient program identification information.

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22. The apparatus of claim 17, wherein said electronic mail message further comprises a password and a second electronic mail message is sent from said apparatus to said user if said password is incorrect.

23. The apparatus of claim 17, wherein a second electronic mail message is sent from said apparatus to said user if said event is scheduled.

24. A video processing apparatus, comprising:

an interface operative to receive an electronic mail message remotely from a user, said electronic mail message comprising an operating command and program identification information including at least one of a first type of program identification information and a second type of program identification information;

a processor operative to process said electronic mail message to determine whether said electronic mail message includes said first type of program identification information, and to schedule an event responsive to said operating command for a program identified by said program identification information without searching program guide information for said program if said electronic mail message includes said first type of program identification information;

said processor continuing to process said electronic mail message to determine whether said electronic mail message includes said second type of program identification information only if said electronic mail message does not include said first type of program identification information; and

said processor searching said program guide information for said program using said program identification information only if said electronic mail message includes said second type of program identification information and does not include said first type of program identification information, and scheduling said event responsive to said operating command if said program is found during said searching.

25. The video processing apparatus of claim 24, wherein:

said first type of program identification information includes channel and time information for said program; and

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said second type of program identification information includes a name of said program.

26. The video processing apparatus of claim 24, wherein said operating command represents one of a request to record said program and a request to watch said program.

27. The video processing apparatus of claim 26, wherein:
said video processing apparatus is scheduled to record said program if said operating command represents said request to record said program; and
said video processing apparatus is scheduled to power on if said operating command represents said request to watch said program.

28. The video processing apparatus of claim 24, wherein a second electronic mail message is sent from said video processing apparatus to said user if said program is not found during said searching, said second electronic mail message indicating that said electronic mail message included insufficient program identification information.

29. The video processing apparatus of claim 24, wherein said electronic mail message further comprises a password and a second electronic mail message is sent from said video processing apparatus to said user if said password is incorrect.

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IX. Evidence Appendix

None.

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X. Related Proceedings Appendix

None.

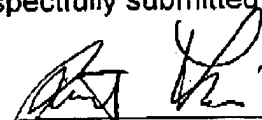
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Respectfully submitted,


By: Reitseng Lin
Reg. No. 42,804
Phone (609) 734-6813

Patent Operations
Thomson Licensing LLC
P.O. Box 5312
Princeton, New Jersey 08540
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